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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/02/2000

Jay S. Walker

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05/27/2009

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3687

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05/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/678,117	Applicant(s) WALKER ET AL.	
	Examiner VANEL FRENEL	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-15, 18-27, 30-31, 33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-7,11-15,18-27,30,31,33,35-37,39-55,59-63,65-75,78-81,83-85 and 87-98.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Request for reconsideration filed on 10/14/08. Claims 1-7, 11-15, 18-27, 30, 31, 33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85 and 87-98 are pending.
2. On 5/14/09, Applicant reiterated that the finality mailed on 1/06/09 was defective because a new 101 rejection was submitted. Hence, the previous Office Action is withdrawn and a new Office Action is hereby presented.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 1-7, 11-15, 18-27, 30-31, 33, 35-37, 39-45, 49-55, 59-63, 65-75, 78-81, 83-85, 87-94 and 97-98 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-7, 11-15, 18-27, 30-31, 33, 35-37, 39-45, 49-55, 59-63, 65-75, 78-81, 83-85, 87-94 and 97-98 recite a process comprising the steps of receiving, determining, offering, receiving and providing. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane*

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v. *Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 11-15, 18-27, 30-31,33, 35-37, 39-55, 59-63, 65-75, 78-81,83-85, and 87-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gamble et al (6,014,632) in view of Lencki et al. (2002/0049617).

As per claim 1, Gamble discloses a method for providing a benefit to a customer, comprising receiving an identification of a customer involved in a transaction with a third party (See Gamble, Co1.1, lines 61-67 to Co1.2, line 11).

Gamble does not explicitly disclose determining a preventative treatment for the customer; offering a benefit to the customer toward the transaction if the customer

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adopts the preventative treatment; receiving an indication that the customer agrees to adopt the preventative treatment; and providing the benefit.

However, this feature is known in the art, as evidenced by Lencki. In particular, Lencki teaches determining a preventative treatment for the customer (See Lencki, Page 13, Paragraph 0182); offering a benefit to the customer toward the transaction if the customer adopts the preventative treatment (See Lencki, Page 13, Paragraph 0182); receiving an indication that the customer agrees to adopt the preventative treatment (See Lencki, Fig.9; Page 9, Paragraphs 0144-0145, Page 13, Paragraph 0182; and providing the benefit (See Lencki, Page 1, Paragraph 0009).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lencki within the system of Gamble with the motivation of providing a wide range of benefit categories, including, but not limited insurance benefits such as health insurance. When healthcare benefits are provided in a manner consistent with the invention, the individual benefit category line items with may include, for example, preventative care, physician care, hospital care, emergency care, pharmacy care, alternative care, vision care, behavioral healthcare services, etc. (See Lencki, Page 1, Paragraph 0009).

As per claim 2, Gamble discloses the method wherein the receiving further comprises receiving the identification from at least one of: the customer, a merchant, a web site operator, an acquaintance of the customer, a family member related to the

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customer, a doctor, a pharmacist, an insurance provider, and a government agency (See Gamble, Co1.9, lines 14-25).

As per claim 3, Gamble discloses the method wherein the identification comprises at least one of: a unique identifier associated with the customer and a name of the customer (See Gamble, Co1.9, lines 1-14).

As per claim 4, Gamble discloses the method wherein said customer is involved in a transaction comprising at least one of: a purchase of a product, a purchase of a service, an insurance premium, and an online purchase (See Gamble, Co1.9, lines 14-24).

As per claim 5, Gamble discloses the method wherein the customer has profile information comprising at least one of: an age of the customer, a gender of the customer, a geographic location corresponding to a residence of the customer, a medical history of the customer, a medical history of the customer's family, an occupation of the customer, a previous preventative treatment adopted by the customer, and at least one preventative treatment not adopted by the customer (See Gamble, Col .49-67).

As per claim 6, Gamble discloses the method wherein the preventative treatment further comprises at least one of: a preventative health treatment, a preventative

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automobile repair, and a preventative home maintenance repair (See Gamble, Co1.12, lines 49-67).

As per claim 7, Gamble discloses the method wherein the preventative health treatment comprises at least one of: a blood test, a cancer screening, a blood pressure screening, a teeth-cleaning treatment, a mammogram, a pap smear, a sigmoidoscopy, a colonoscopy, an immunization, a psychiatric examination, a psychological examination, a dental examination and a physical examination (See Gamble, Co1.14, lines 11-26).

As per claim 11, Gamble discloses the method wherein said determining a preventative treatment further comprises determining a plurality of preventative treatments, the method further comprising: comprising a cost associated with each of said plurality of preventative treatments (See Gamble, Co1.16, lines 15-27); and selecting at least one of said plurality of preventative treatments based on said comparing (See Gamble, Co1.18, lines 42-56).

As per claim 12, Gamble discloses the method wherein said selecting further comprises: selecting a preventative treatment having a lowest cost (See Gamble, Co1.20, lines 54-67 to Co1.21, line 33).

As per claim 13, Gamble discloses the method wherein the preventative treatment corresponds to at least one condition (See Gamble, Co1.20, lines 20-67).

As per claim 14, Gamble discloses the method further comprising: determining a future cost for the at least one condition, wherein the future cost is determined based on a probability of the customer contracting the condition (See Gamble, Co1.20, lines 20-67).

As per claim 15, Gamble discloses the method further comprising: determining a future cost for the at least one condition, wherein the future cost is determined based on a probability of the customer contracting the condition within a predetermined time (See Gamble, Co1.20, lines 20-67).

As per claim 18, Gamble discloses the method further comprising: receiving a confirmation from a third party that the preventative treatment has been adopted by the customer (See Gamble, Co1.4, lines 13-37).

As per claim 19, Gamble discloses the method further comprising: updating profile information for the customer based on the confirmation (See Gamble, Col .11, lines 16-65).

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As per claim 20, Gamble discloses wherein the benefit is provided by an insurer of the customer (See Gamble, Col.9, lines 1-24).

As per claim 21, Gamble discloses the method wherein the benefit is determined based on a probability that the customer will remain insured by the insurer for a predetermined time (See Gamble, Co1.9, lines 1-41).

As per claim 22, Gamble discloses the method further comprising:
receiving a security for the benefit from the customer (See Gamble, Col.9, lines 1-41).

As per claim 23, Gamble discloses the method wherein the security comprises an authorization to charge a financial account in the amount of the benefit (See Gamble, Co1.7, lines 8-23).

As per claim 24, Gamble discloses the method wherein the financial account comprises at least one of; a checking account, a savings account, a credit card account, and an alternative currency account (See Gamble, Co1.9, lines 14-25).

As per claim 25, Gamble discloses the method wherein the security is used to reimburse the payment of the benefit when a predetermined condition is not met (See Gamble, Co1.4, lines 38-67 to Co1.5, line 35).

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As per claim 26, Gamble discloses the method wherein the predetermined condition comprises a determination that the preventative treatment was adopted (See Gamble, Co1.6, lines 13-47).

As per claim 27, Gamble discloses the method wherein the predetermined condition comprises a determination that the preventative treatment was adopted within a predetermined time (See Gamble, Co1.9, lines 1-41).

As per claim 30, Gamble discloses the method further comprising: assigning a treatment provider for the selected preventative treatment (See Gamble, Co1.9, lines 1-33).

As per claim 31, Gamble discloses the method wherein the benefit comprises at least one of: a currency amount, an alternate currency amount, a percentage discount on a purchase, and a reduced insurance premium (See Gamble, Co1.9, lines 1-41).

As per claim 33, Gamble discloses the method in which providing the benefit comprises a confirmation that the preventative treatment has been adopted (See Gamble, Co1.13, lines 1-48).

As per claim 35, Gamble discloses the method further comprising: determining the benefit based on an expected future cost (See Gamble, Co1.17, lines 63-67 to

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Co1.18, line 56).

As per claim 36, Gamble discloses the method further comprising: determining a present value of a future cost associated with the preventative treatment (See Gamble, Co1.17, lines 63-67 to Co1.18, line 56); and determining the benefit based on the present value (See Gamble, Co1.19, lines 1-67).

As per claim 37, Gamble discloses the method wherein the benefit is provided in at least one installment payment (See Gamble, Co1.20, lines 20-65).

As per claim 39, Gamble discloses the method wherein the benefit is provided by at least one of: an insurer, a group of insurers, a physician, an employer, a family member of the customer, a government agency, a drug manufacturer, a medical equipment manufacturer, an automobile repair center and a maintenance provider (See Gamble, Co1.18, lines 41-56).

As per claim 40, Gamble discloses the method further comprising: receiving a medical statistic of the customer with the identification (See Gamble, Co1.17, lines 63-67 to Co1.18, line).

As per claim 41, Gamble discloses the method wherein the identification does not include a name of the customer (See Gamble, Co1.20, lines 54-65).

As per claim 42, Lencki discloses the method wherein the preventative treatment comprises an agreement to avoid the undertaking of a hazardous activity (See Lencki, Page 4, Paragraph 0083).

The motivation for combining the respective teachings of Gamble and Lencki are as discussed in the rejection of claim 1, and incorporated herein.

As per claim 43, Gamble discloses the method wherein the preventative treatment comprises an educational assignment regarding a condition (See Gamble Col.13, lines 56-67 to Co1.14, line 41).

As per claim 44, Gamble discloses the method wherein the educational assignment comprises at least one of: attendance of an educational seminar and reading educational literature (See Gamble, Co1.13, lines 56-67 to Co1.14, line 41).

As per claim 45, Gamble discloses the method wherein said determining a preventative treatment further comprises determining a preventative treatment based on profile information corresponding to the customer (See Gamble, Co1.4, lines 38-67).

As per claim 46, Gamble discloses an apparatus for providing a benefit to a customer, comprising: means for accepting an identification of a customer involved in a

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transaction (See Gamble, Co1.1, lines 61-67 to Co1.2, line 11); means for specifying a preventative treatment to the customer (Co1.1, lines 61-67 to Co1.2, line 11).

Gamble does not explicitly disclose that the apparatus having means for presenting an offer of a benefit to the customer toward the transaction if the customer adopts the preventative treatment; means for receiving an indication that the customer agrees to adopt the preventative treatment; and means for providing the benefit.

However, this feature is known in the art, as evidenced by Lencki. In particular, Lencki suggests that the apparatus having means for presenting an offer of a benefit to the customer toward the transaction if the customer adopts the preventative treatment (See Lencki, Page 1, Paragraph 0009); means for receiving an indication that the customer agrees to adopt the preventative treatment (See Lencki Fig.9; Page 9, Paragraphs 0144-0145, Page 13, Paragraph 0182); and means for providing the benefit (See Lencki, Page 1, Paragraph 0009).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lencki within the system of Gamble with the motivation of providing a wide range of benefit categories, including, but not limited insurance benefits such as health insurance. When healthcare benefits are provided in a manner consistent with the invention, the individual benefit category line items with may include, for example, preventative care, physician care, hospital care, emergency care, pharmacy care, alternative care, vision care, behavioral healthcare services, etc. (See Lencki, Page 1, Paragraph 0009).

As per claim 47, Gamble discloses an apparatus for providing a benefit to a customer, comprising:
a processor (See Gamble, Co1.9, lines 46-50); and a memory in operative communication with the processor, the memory including a plurality of processing instructions for directing the processor to: receive an identification of a customer involved in a transaction (See Gamble, Co1.1, lines 61-67 to Co1.2, line 11); identify a preventative treatment for the customer (See Gamble, Co1.13, lines 56- 67 to Co1.14, line 36).

Gamble does not explicitly disclose that the apparatus having offer a benefit to the customer for toward the transaction if the customer adopts the preventative treatment; receive an indication that the customer agrees to adopt the preventative treatment; and provide the benefit.

However, this feature is known in the art, as evidenced by Lencki. In particular, Lencki suggests that the apparatus having offer a benefit to the customer for toward the transaction if the customer adopts the preventative treatment (See Lencki, Fig.9; Page 9, Paragraphs 0144-0145, Page 13, Paragraph 0182); receive an indication that the customer agrees to adopt the preventative treatment (See Lencki, Fig.9; Page 9, Paragraphs 0144-0145, Page 13, Paragraph 0182); and provide the benefit (See Lencki, Page 1, Paragraph 0009).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lencki within the system of Gamble with the motivation of providing a wide range of benefit categories, including, but not limited

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insurance benefits such as health insurance. When healthcare benefits are provided in a manner consistent with the invention, the individual benefit category line items with may include, for example, preventative care, physician care, hospital care, emergency care, pharmacy care, alternative care, vision care, behavioral healthcare services, etc. (See Lencki, Page 1, Paragraph 0009).

As per claim 48, Gamble discloses a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for providing a benefit to a customer, the method comprising:
receiving an identification of a customer involved in a transaction (See Gamble, Co1.13, lines 1-55); identifying a preventative treatment for the customer (See Gamble, Co1.13, lines 1-55).

Gamble does not explicitly disclose that the method having offering a benefit to the customer toward the transaction if the customer adopts the preventative treatment; receiving an indication that the customer agrees to adopt the preventative treatment; and providing the benefit.

However, this feature is known in the art, as evidenced by Lencki. In particular, Lencki suggests that the method having offering a benefit to the customer toward the transaction if the customer adopts the preventative treatment (See Lencki, Fig.9; Page 9, Paragraphs 0144-0145, Page 13, Paragraph 0182); receiving an indication that the customer agrees to adopt the preventative treatment (See Lencki, Fig.9; Page 9,

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Paragraphs 0144-0145, Page 13, Paragraph 0182); and providing the benefit (See Lencki, Page 1, Paragraph 0009).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lencki within the system of Gamble with the motivation of providing a wide range of benefit categories, including, but not limited insurance benefits such as health insurance. When healthcare benefits are provided in a manner consistent with the invention, the individual benefit category line items with may include, for example, preventative care, physician care, hospital care, emergency care, pharmacy care, alternative care, vision care, behavioral healthcare services, etc. (See Lencki, Page 1, Paragraph 0009).

As per claim 49, Gamble discloses a method for providing a benefit, comprising: receiving a first identification of a transaction involving a customer (See Gamble, Co1.1, lines 61-67 to Co1.2, line 32); transmitting a second identification of a preventative treatment to be adopted by the customer (See Gamble, Co1.1, lines 61-67 to Co1.2, line 32); and providing a benefit to the customer toward the transaction (See Gamble, Co1.6, lines 28-58).

Gamble does not explicitly disclose that the method having receiving an indication that the preventative treatment has been adopted by the customer.

However, this feature is known in the art, as evidenced by Lencki. In particular, Lencki suggests that the method having receiving an indication that the preventative

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treatment has been adopted by the customer (See Lencki, Fig.9; Page 9, Paragraphs 0144-0145, Page 13, Paragraph 0182).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lencki within the system of Gamble with the motivation of providing a wide range of benefit categories, including, but not limited insurance benefits such as health insurance. When healthcare benefits are provided in a manner consistent with the invention, the individual benefit category line items with may include, for example, preventative care, physician care, hospital care, emergency care, pharmacy care, alternative care, vision care, behavioral healthcare services, etc. (See Lencki, Page 1, Paragraph 0009).

Claims 94 and 95-96 recite the same limitations as claim 49 above are therefore rejected for the same reasons given in claim 49, and incorporated herein.

As per claim 97, Gamble discloses a method for providing a benefit, comprising: receiving a first identification of a transaction between a customer and a third party (See Gamble, Co1.1, lines 61-67 to Co1.2, line 11); determining a preventative treatment and a benefit (See Gamble, Co1.1, lines 61- 67 to Co1.2, line 32); transmitting a second identification of the preventative treatment and a third identification of the benefit to the customer (See Gamble, Co1.1, lines 61-67 to Co1.2, line 11); providing the benefit toward the transaction between the customer and

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the third party in response to said indication (See Gamble, Co1.1, lines 61-67 to Co1.2, line 32).

Gamble does not explicitly disclose that the method having receiving an indication that the preventative treatment has been adopted by the customer.

However, this feature is known in the art, as evidenced by Lencki In particular, Lencki suggests that the method having receiving an indication that the preventative treatment has been adopted by the customer (See Lencki, Fig.9; Page 9, Paragraphs 0144-0145, Page 13, Paragraph 0182).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lencki within the system of Gamble with the motivation of providing a wide range of benefit categories, including, but not limited insurance benefits such as health insurance. When healthcare benefits are provided in a manner consistent with the invention, the individual benefit category line items with may include, for example, preventative care, physician care, hospital care, emergency care, pharmacy care, alternative care, vision care, behavioral healthcare services, etc. (See Lencki, Page 1, Paragraph 0009).

As per claim 98, Gamble discloses the method wherein a value for the benefit is determined from an expected future cost corresponding to the preventative treatment (See Gamble, Co1.21, lines 15-56).

Claims 50-55, 59-63, 65-75, 78-81,83-85 and 87-93 recite the underlying process steps of the elements of claims 2-7, 11-15, 18-20, 22-27, 30-31,35-37 and 39- 45, respectively. As the various elements of claims 2-7, 11-15, 18-20, 22-27, 30-31,35- 37 and 39-45 and have been shown to either disclosed by or obvious in view of the collective teachings of Gamble and Lencki, it is apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 50-55, 59-63, 65-75, 78-81,83-85 and 87-93 are rejected for the same reasons given above for method claims 2-7, 11-15, 18-20, 22-27, 30-31,35-37 and 39-45, and incorporated herein.

Response to Arguments

6. Applicant's arguments filed on 10/14/08 with respect to claims 1-7, 11-15, 18-27, 30, 31, 33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85 and 87-98 have been fully considered but they are not persuasive.

(A) At pages 1-11 of the response filed on 10/14/08, Applicant argues the followings:

(i) Gamble does not disclose determining a preventative treatment and offering a benefit to the customer for the transaction if the customer adopts the preventative treatment.

(ii) Gamble and Lencki fail to establish a prima facie case of obviousness.

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(B) With respect to Applicant's first argument, the Examiner respectfully submitted that He relied upon the clear teaching of Lencki (See Lencki, Fig. 9; Page 1, Paragraph 0009; Page 9, Paragraphs 0144-0145; Page 13, Paragraph 0182) which correspond to Applicant's claimed feature. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's second arguments, the Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.11 I(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the

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language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. In re Cole, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); In re Schu/ze, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); Mertizner v. Mindick, 549 F.2d 775, 193 USPQ 17 (CCPA 1977). In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by What the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in In re DeLisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ 871; and In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in In re Lamberti et al, 192 USPQ 278 (CCPA) that:

(i) obviousness does not require absolute predictability;

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- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769.

The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nanel Frenel/

Examiner, Art Unit 3687

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